

### **REMARKS**

This Amendment is responsive to the Office Action of March 9, 2007. A Request for a One-Month Extension of Time is being filed concurrently herewith. Reconsideration and allowance of claims 1, 2, 4, and 6-16 are requested.

### **The Office Action**

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-4 and 7 stand rejected under 35 U.S.C. § 102 as being anticipated by Byers (US 4,969,468).

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being obvious over Byers in view of Owen (US 6,148,233).

### **The References of Record**

**Byers** discloses an electrode which includes a silicon base **7**, a silicon dioxide insulating layer **8**, and a metallic layer **9**. Note that the metallic layer or film **9** is not an elastic material.

Metal cones **12**, **13**, are grown on the metallic film by deposition through a mask **11**. After the cones are completely grown, the mask is removed, leaving the cones atop the metallic film **9** (column 6, lines 38-62).

The deposited metal cones each taper to a point because the holes in the mask become progressively smaller as metal is deposited atop the mask. The reduction in hole size reduces the cross-sectional area of the cone, forming it into a cone or pyramid (column 12, lines 25-40).

It should be noted that the foil layer is etched to remove material to define a conductive pattern (column 12, lines 8-17).

Optionally, a glass passivation layer **10** is laid down on the electrical conductors and needle sites are etched through the glass passivating layer down to the metal conductors **9** (column 12, lines 18-24). The needles or cones are then grown, as described above, in the etched needle sites.

Byers suggests that the substrate **7** could be flexible, but indicates that suitable bases include silicon, sapphire, or germanium, all common semiconductor

materials which are not normally flexible. Moreover, Byers does not suggest that the vapor deposited metal needles be of a flexible material (column 10, lines 22-30).

As shown in Figure 11 and described at column 7, lines 58-62, having a space between the silicon dioxide wells in which the needles are formed and the needles is important so that tissue, particularly nerve fibers, can grow into the region surrounding the needles or be penetrated by the needles.

Thus, the construction formed by Byers is in the nature of a semiconductor chip and is not flexible or elastomeric.

Owen shows a wearable pad which carries electrodes.

**The Claims Distinguish Patentably Over**  
**The References of Record**

Applicants respectfully submit that the Office has not established a *prima facie* case of unpatentability. The Office explains in one sentence what it believes is disclosed in the Byers reference. However, the Office does not conduct an element-by-element analysis. The Office does not explain specifically which features of the reference correspond to which claimed elements. The Office is required to therefore respond with a specific explanation (e.g., correlating specific features of the reference to the claimed elements and limitations; identifying specific reference numerals and elements in the drawings and correlating the reference numerals and elements to the claimed elements and limitations) as opposed to a general reference to figures and columns and lines without any explanation whatsoever. The BPAI has previously held that in order to establish a *prima facie* case, the Office must identify which features of the cited reference(s) correspond to the claimed elements and limitations. *Ex Parte Naoya Isoda* , Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

Applicants respectfully remind the Examiner that it is the duty of the Examiner to specifically point out each and every limitation of a claim being rejected as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly state that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Thus, the Office is respectfully requested to more clearly identify each feature of the Byers reference by reference number and to

identify the corresponding claimed element for each identified feature.

Applicants expect that the next Official Action, if any, will not be a final Action since Applicant needs further clarification. MPEP 706 points out that "the goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." As the Office's rejection is not entirely understood, Applicants have not received the appropriate and required opportunity to respond. In the meantime, as a good faith effort to advance prosecution, Applicants make the following remarks.

**Claim 1** calls for an electrode body of an electrically conductive elastic material. It is not clear which element(s) in Byers are considered by the Examiner to correspond to the claimed elements. In order to advance prosecution, it is assumed for now that the Examiner deems the metal foil **9** which is etched to define a circuit, to be the claimed electrode body of an electrically conductive elastic material. A metal foil is not an electrically conductive elastic material.

Claim 1 further calls for the projections to be of an electrically conductive elastic material. The vapor deposited metal needles of Byers are not an electrically conductive elastic material.

Accordingly, it is submitted that **claim 1 and claims 2, 4, 6, and 13-16 dependent therefrom** are not anticipated by Byers.

Moreover, dependent **claim 16** calls for the electrode body to be an electrically conductive rubber. Byers does not suggest the use of rubber materials.

**Claim 7** calls for an electrode for use in a monitoring system. Claim 7 again calls for an electrically conductive elastic layer. By distinction, Byers calls for a metallic foil which is not an elastic material.

Claim 7 further calls for flexible insulating layers covering and insulating the faces of the electrically conductive elastic layer. By contrast, Byers suggests the use of silicon dioxide insulating layers. Moreover, the upper silicon dioxide layer is etched to define bores or holes through the film to the layer of the metallic foil. Uninsulating generally cylindrical regions around each needles are needed to receive tissue as it grows around the electrode.

Claim 7 further calls for a plurality of metallic elements embedded in the electrically conductive elastic layer. By contrast, Byers deposits metal needles on a metallic foil layer.

Accordingly, it is submitted that **claim 7** is not anticipated by and differentiates patentably over Byers.

**Claim 8** calls for the electrically conductive elastic layer to be a conductive rubber. By contrast, Byers has a metal foil layer.

Claim 9 calls for the insulating layers to be plastic. By distinction, Byers uses silicon oxide insulators.

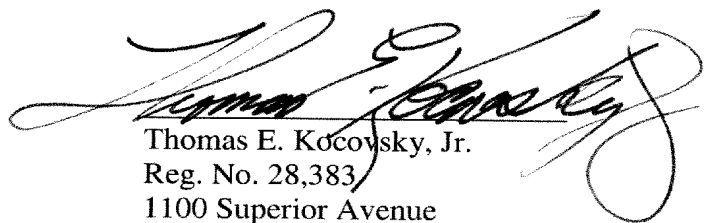
Accordingly, it is submitted that **claim 7 and claims 8-12 dependent therefrom** distinguish patentably and unobviously over the references of record.

#### CONCLUSION

For the reasons set forth above, it is submitted that claims 1, 2, 4, and 6-16 distinguish patentably and unobviously over the references of record. An early allowance of all claims is requested.

Respectfully submitted,

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